be found in the specification at page 2, lines 23-27 and original claims 1-12. Support for claims 24-31 may be found in the specification at page 4, lines 18-19 and at page 5, lines 30-35. Support for claims 51-58 may be found in the specification at page 2, lines 23-27, at page 4, lines 18-19 and at page 5, lines 30-35. Support for claims 32 and 59 may be found in the specification at page 4, line 15. Support for claims 33-36 and 60-63 may be found in the specification at page 1, lines 30-35. Support for claims 37-42 and 64-69 may be found in the specification at page 2, lines 16-21. Further support for claim 40 and 66 may be found in the specification at page 2, lines 29-32. Support for claim 70 may be found in the specification at page 7. No matter has been added.

Applicants particularly wish to note that the recitation of the use of Compound (I) at a dosage range of 1-12 mg is not new matter. Original claim 2 and the specification at page 1, lines 28-29 recites that "up to 12 mg" of Compound (I) can be administered per day. Original claim 3 and the specification at page 1 lines 36-37, further limit the recited dosage range of Compound (I) to "2 to 12 mg". The specification at page 5, lines 30-35, clearly recites that suitable unit dosages of Compound (I) include 1 mg of Compound (I), that may be administered 1 to 2 times per day. As the range "1 to 12 mg" is encompassed within the range "up to 12 mg", the recited method of administering 1 to 12 mg of Compound(I) per day does not add new matter.

For the avoidance of doubt, Applicant notes that, as set forth in the specification, "5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione" (or "Compound (I)") may exist in one of several tautomeric forms, as individual tautomeric forms or as mixtures thereof, all of which are encompassed by the term "Compound (I)" or "5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione". Furthermore, 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione contains a chiral atom, and therefore can exist in up to two stereoisomeric forms. The term "5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione" (or "Compound (I)") also encompasses all of these isomeric forms, whether as individual isomers or as mixtures of isomers, including racemates. See the specification at page 2, lines 33-37. Accordingly, when reference is made to

"Compound (I)", or to "5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione", or to "5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione, or a tautomer thereof", or to "said 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione ", all tautomeric and isomeric forms of the compound are intended to be encompassed.

Additionally for the avoidance of doubt, as set forth in the specification, when reference is made to scalar amounts, including mg amounts and % weight amounts, of "5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione in a pharmaceutically acceptable form" (or as in the claims: "said 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione in a pharmaceutically acceptable form"), the scalar amount referred to is made in respect of 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione per se: for example, 2 mg of Compound (I), or 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione, in the form of the maleate salt is that amount of maleate salt which contains 2 mg of 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione (not: 2 mg of 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione maleate salt). See the specification, page 3, lines 23-27.

Although no official action has been taken regarding claims 16-70, these claims define the same subject matter and contain many of the same terms as original claims 1-11 and 13-15 that were examined and were the subject of the Office Action dated November 13, 2002. To expedite prosecution of the subject application, Applicant will address the objections raised in the Office Action to the extent that they pertain to the claims. Original claims 1-11 and 13-15 had been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Applicant's admissions at page 1, lines 6-18 of the subject specification ("the Background discussion"). Applicant respectfully traverses the rejection in the Office Action.

It is well settled that to establish a *prime facie* case of obviousness, there must be 1) some motivation to modify the cited reference, 2) a reasonable expectation of success, and 3) the prior art reference must teach or suggest all the claim limitations.

To expedite prosecution of the subject application, Applicant has presented new claims that are limited to the use of 1-12 mg per day of 5-[4-[2-(N-methyl-N-(2-pyridyl)amino)ethoxy]benzyl]thiazolidine-2,4-dione with insulin. Applicant respectfully submits that the Background discussion, or the art cited therein, fails to disclose or provide any suggestion to use Compound (I) and insulin in the specifically recited amounts as provided in new claims 16-70 to treat diabetes mellitus, particularly Type II diabetes, and conditions associated therewith.

The Examiner rejected original claims 1-11 and 13-15 , contending that it would have been *prima facie* obvious to administer cojointly insulin and Compound (I) to treat diabetes. This argument fails to recognize the specificity of the dosing ranges as defined in original claims 2-10. Applicants respectfully submit that the Background discussion fails to support a *prime facie* case of obviousness by:

1) failing to provide any motivation to select the claimed dosages of Compound (I) to be used in combination with insulin to treat diabetes mellitus and conditions associated therewith, specifically Type II diabetes;

2) failing to provide any guidance or a basis for expectation of success that Compound (I) can be used, in combination with insulin, in the amount of 1 to 12 mg per day to treat diabetes mellitus and conditions associated therewith, specifically Type II diabetes;

3) failing to disclose or suggest that Compound (I) can be used in the amount of 1 to 12 mg per day, in combination with insulin, to treat diabetes mellitus and conditions associated therewith, specifically Type II diabetes; and

4) failing to disclose or suggest administering Compound (I) one to two times per day in a unit dosage form of 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, or 12 mg, in combination with insulin, to treat diabetes mellitus and conditions associated therewith, specifically Type II diabetes.

Assuming *arguendo*, that it would have been obvious to try to treat diabetes mellitus and conditions associated therewith in patients using Compound (I) in combination with insulin, the Background discussion fails to disclose or suggest that patients can be effectively treated using Compound (I) and insulin, wherein Compound (I) is used in the amount of 1 to 12 mg per